

Serial No. 10/501,750**Atty. Doc. No. 2002P00211WOUS****REJECTIONS UNDER 35 U.S.C. 103(a)**

M.P.E.P. 2143.04 provides that to establish *prima facie* obviousness of a claimed invention, all the claims limitations must be taught or suggested by the prior art. All words in a claim must be considered for judging the patentability of the claim against the prior art. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.

Claim 18 is directed to a method for requesting the agreement of a user of a mobile terminal 13 (FIG. 3) of a mobile radio network to the transfer of their position data to a party, e.g., Locator Services Application (LCS) 11, requesting this position data. The method allows providing a central privacy entity 26 comprising a database server for storing privacy data 18 regarding the mobile terminal. In particular, the central privacy entity constitutes a separate entity from a Home Location Register (HLR) 16 for the mobile terminal. The privacy data 18 stored in the database server at the central privacy entity is defined to assign to the mobile terminal at least one verification rule as to whether an agreement must be obtained on the mobile terminal side to forward the mobile terminal position to the requester. The switching center 14 of the mobile radio network (in the event of the arrival of a request from a requester for the position of the mobile terminal) causes the database server at the central privacy entity 26 to make a check on the basis of the privacy data stored there. The results of the check performed at the central privacy location 26 are sent to the switching center 14. If the result indicates that an agreement must be obtained, the switching center 14 sends a request for an agreement to the mobile terminal. If the agreement is received by the switching center, then the position of the mobile terminal is sent by the switching center to the requester.

The Office communication correctly acknowledges that Havinis fails to disclose or suggest that the central privacy entity constitutes a separate entity from a Home Location Register (HLR) for the mobile terminal. The Office communication then applies Jokimies to purportedly remedy the deficiencies of Havinis regarding the claimed invention. However, as discussed in greater detail below, the combination of Jokimies with Havinis fails to result in the claimed invention.

Jokimies is directed to cell prioritizing in a cellular radio system. The claimed invention is directed to safeguarding privacy data, such as when a user of a mobile terminal is requested to

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transfer their position data to a party requesting such position data. The issues that arise in the context of cell prioritizing have virtually nothing to do with safeguarding privacy data. For example, Jokimies describes at column 2, lines 12- 52, some of the reasons as to why cell prioritizing may be used, e.g., utilization of limited resources in areas with dense radio communication traffic, or offering cheaper tariffs to some of the subscribers. None of this has anything to do with safeguarding privacy data, such as when a user of a mobile terminal is requested to the transfer their position data to a party requesting such position data. Applicant respectfully submits that Jokimies does not consider any privacy issues, as does the claimed invention. Although Jokimies may use a database 37, the utilization of such a database is inapplicable regarding the claimed invention. Database 37 purports to contain a list of priority cell identities. However, one skilled in the art would not analogize a list of priority cell identities, as described by Jokimies, with privacy data defined to assign to the mobile terminal at least one verification rule as to whether an agreement must be obtained on the mobile terminal side to forward the mobile terminal position to the requester. Cell prioritizing may be useful to the operator who manages a cellular radio system (see Jokimies col. 9, lines 4-29) but cell prioritizing does not serve to safeguard the privacy data of any given subscriber. Accordingly, Jokimies fails to remedy the deficiencies of Havinis, and the Havinis/Jokimies references, singly or in combination, fail to meet the burden required to make a *prima facie* case to sustain a 103 rejection. Accordingly, the rejection of claim 18, and claims depending from that claim, should be withdrawn.

In connection with dependent claim 28, it is respectfully submitted that Koch fails to overcome the fundamental deficiencies of Havinis/Jokimies noted above in connection with claim 18, the parent claim of claim 28. Consequently, the Havinis/Jokimies/Koch combination fails to render unpatentable claim 28.

Claim 34 is directed to a computer readable media containing program instructions for requesting the agreement of a user of a mobile terminal of a mobile radio network to the transfer of their position data to a party requesting this position data. It is respectfully submitted that in view of the foregoing discussion Havinis/Jokimies also fails render unpatentable claim 34.

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It is respectfully submitted that each of the claims pending in this application recites patentable subject matter and it is further submitted that such claims comply with all statutory requirements and thus each of such claims should be allowed.

The commissioner is hereby authorized to charge any appropriate fees due in connection with this paper, including the fees specified in 37 C.F.R. §§ 1.16 (c), 1.17(a)(1) and 1.20(d), or credit any overpayments to Deposit Account No. 19-2179.

Respectfully submitted,

Dated: 2/21/07

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